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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,550	03/20/2001	Hideyuki Hirano	1405.1039	9079

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EXAMINER

NORRIS, TREMAYNE M

ART UNIT PAPER NUMBER

2137

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/811,550

Applicant(s)

HIRANO ET AL.

Examiner

Tremayne M. Norris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/20/2001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 9,15,16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "vital information" in claims 9,15,16 is a relative term which renders the claim indefinite. The term "vital information" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

3. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 21 recites the limitation "electronic watermark embedding mode". There is insufficient antecedent basis for this limitation in the claim.

Priority

4. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 10/11/00. It is noted, however, that applicant has

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not filed a certified copy of the 2000-342753 application as required by 35

U.S.C. 119(b).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komuro et al (US pat 6,223,285), and further in view of Saito (US pat 6,182,218).

Regarding claim 1, Komuro teaches a data administration method, which comprises:

preparing a real data section by encrypting digital content to be distributed (col.5 lines 31-36);

preparing a header data section provided with symbol information symbol-converted for visual or auditory recognition of attributes of the digital content (col.5 lines 31-36; col.13 lines 4-17);

preparing a consent-information-added header data section in which consent information containing information on a content key used as an encryption key in encrypting the digital content is embedded in the header data section (col.4 lines 44-46; col.7 lines 30-67); and

preparing composite data in which the real data section and the consent-information-added header data section are composited, and distributing the composite data (col.7 lines 30-67).

Komuro does not teach embedding information in an electronic watermark. Saito teaches embedding information in an electronic watermark (col.5 lines 55-62). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Komuro's system for transferring information with Saito's digital content system using watermarks in order to provide a system that checks the validity and integrity of users by using watermarks (Saito col.5 lines 55-62).

Regarding claim 3, Komuro and Saito in combination teach everything as claimed above (claim 1), in addition Komuro teaches preparing an annex data section in which use restriction information for restricting use of the digital content is encrypted (col.5 line 37 thru col.6 line 17).

Regarding claim 4, Komuro and Saito in combination teach the method as in claim 3, in addition Komuro teaches use restriction information is embedding

logic for embedding the consent information as the electronic watermark in the header data section (col.5 line 37 thru col.6 line 17).

Regarding claim 5, Komuro and Saito in combination teach the method as in claim 3, in addition Komuro teaches use restriction information is based on a use term during which, or on a use count up to which, the digital content is usable (col.6 lines 1-25).

Regarding claim 6, Komuro and Saito in combination teach the method as in claim 3, in addition Komuro teaches the use restriction information is encrypted with, as an encryption key, personal information on a user of the digital content (col.7 lines 47-62).

Regarding claim 7, Komuro and Saito in combination teach the method as in claim 6, in addition Komuro teaches the encryption key when encrypting the use restriction information is a password preset by the user (col.11 lines 23-27).

Regarding claim 8, Komuro and Saito in combination teach the method as in claim 6, in addition Komuro teaches the encryption key when encrypting the use restriction information is identifying information specific to a recording medium (EMI modes) in which the composite data is recorded (col.7 lines 47-62; col.8 lines 23-46).

Regarding claim 9, Komuro and Saito in combination teach the method as in claim 6, in addition Komuro teaches the encryption key when encrypting the use restriction information is vital information on the user (col.7 lines 47-62).

Regarding claim 10, Komuro teaches a data administration method, which comprises:

- separating an annex data section from composite data distributed as a composite of

- a real data section in which digital content to be distributed is encrypted,
 - in a header data section enabling visual or auditory recognition of substance of the digital content, a consent-information-added header data section in which consent information containing information on a content key used as an encryption key in encrypting the digital content is embedded, and

- an annex data section in which use restriction information for restricting use of the digital content is encrypted;

- decrypting the annex data section and extracting the use restriction information;

- extracting the consent information embedded in the consent-information-added header data section based on the use restriction information;

- obtaining from the consent information a content key for decrypting the digital content; and

- using the content key, decrypting the real data section into its original digital content to allow use by users (col.7 line 47 thru col.8 line 46).

Komuro does not teach embedding information in a visually or auditorily unrecognizable electronic watermark. Saito teaches embedding information in a visually or auditorily unrecognizable electronic watermark (col.5 lines 55-62). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Komuro's system for transferring information with Saito's digital content system using watermarks in order to provide a system that checks the validity and integrity of users by using watermarks (Saito col.5 lines 55-62).

Regarding claim 11, Komuro and Saito in combination teach everything as in claim 1, in addition Komuro teaches embedding in the header data section as a visually or auditorily unrecognizable electronic watermark a hash value generated from the real data section using a hash function (col.9 lines 22-36).

Regarding claim 12, Komuro and Saito in combination teach everything as in claim 11, in addition Komuro teaches decrypting the real data section into digital content for sending out, by line-connecting to a predetermined contact destination, content information from the digital content that is decrypted (col.8 lines 6-46), and therein

embedding in the header data section as a visually or auditorily unrecognizable electronic watermark the content information from the digital content that is decrypted and information on the predetermined contact destination (col.12 lines 5-20).

Regarding claim 13, Komuro and Saito in combination teach everything as in claim 11, in addition Saito teaches preparing composite data in which the real data section and the consent-information-added header data section are composited, and therein retaining within the composite data record-location information from a server in which the digital content is registered (col.12 lines 58-62; col.13 lines 8-10).

Regarding claim 14, Komuro and Saito in combination teach everything as in claim 13, in addition Saito teaches the record-location information from the server in which the digital content is registered is embedded in the header data section as a visually or auditorily unrecognizable electronic watermark (col.12 lines 58-62; col.13 lines 8-10).

Regarding claim 15, Komuro and Saito in combination teach everything as in claim 11, in addition Komuro teaches preparing composite data in which the real data section and the consent-information-added header data section are composited, and therein retaining within the composite data vital template information generated based on vital information on a user of the digital content (col.7 lines 30-67).

Regarding claim 16, Komuro and Saito in combination teach everything as in claim 15, in addition Saito teaches the vital template information is embedded

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in the header data section as a visually or auditorily unrecognizable electronic watermark (col.5 lines 55-62).

Regarding claim 17, Komuro and Saito in combination teach everything as in claim 11, in addition Komuro teaches identifying information specific to a recording medium (EMI modes) for recording the digital content (col.7 lines 47-62; col.8 lines 23-46).

Regarding claim 18, Komuro and Saito in combination teach everything as in claim 11, in addition Komuro teaches a control code allowing a given operation on an information device for reproducing the digital content (col.6 lines 1-45).

Regarding claim 19, Komuro and Saito in combination teach everything as in claim 11, in addition Komuro teaches privileges information for the digital content including copyright information is embedded within the digital content as an electronic watermark (col.6 lines 1-45).

Regarding claim 20, Komuro and Saito in combination teach the method of claim 19, in addition Komuro teaches the morphology and code level of the electronic watermark embedded in the digital content are determined based on a data quality level and a security level required by the digital content (col.5 line 37 thru col.6 line 45).

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Komuro et al and Saito, and further in view of Peinado et al (US pat 6,775,655).

Regarding claim 2, Komuro and Saito in combination teach the data administration method as in claim 1, but does not teach said header data section is made by compositing into one image data item more than one image-symbol data item symbol-converted for visually recognizing attributes corresponding respectively to a plurality of digital content items. Peinado teaches header data section is made by compositing into one image data item more than one image-symbol data item symbol-converted for visually recognizing attributes corresponding respectively to a plurality of digital content items (col.13 line 61 thru col.14 line 11). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Komuro's system of transferring information with Peinado' system for rendering digital content in an encrypted rights protection form in order to provide secure method for distributing digital content that will allow the digital content to be only rendered as specified by the content provider (Peinado col.2 lines 20-41).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tremayne M. Norris whose telephone number

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is (571) 272-3874. The examiner can normally be reached on M-F 7:30AM-5:00PM alternate Fridays.

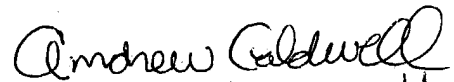
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tremayne Norris

September 2, 2004


Andrew Caldwell